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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/538,359	06/13/2005	Dirk Rottger	273059US0XPCT	5796
22850	7590	08/20/2008		
OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, P.C.			EXAMINER	
1940 DUKE STREET			CHUNG, SUSANNAH LEE	
ALEXANDRIA, VA 22314			ART UNIT	PAPER NUMBER
			1626	
NOTIFICATION DATE	DELIVERY MODE			
08/20/2008	ELECTRONIC			

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patentdocket@oblon.com  
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<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	10/538,359	ROTTGER ET AL.
	<b>Examiner</b> Susannah Chung	<b>Art Unit</b> 1626

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If no period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 30 June 2008.  
 2a) This action is FINAL.      2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-6,8 and 10-12 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 1-6, 8 and 10-12 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) Notice of References Cited (PTO-892)  
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)  
 3) Information Disclosure Statement(s) (PTO-166/08)  
 Paper No(s)/Mail Date \_\_\_\_\_

4) Interview Summary (PTO-413)  
 Paper No(s)/Mail Date \_\_\_\_\_  
 5) Notice of Informal Patent Application  
 6) Other: \_\_\_\_\_

### **DETAILED ACTION**

Claims 1-6, 8, and 10-12 are pending in the instant application. Claims 7 and 9 are canceled. New claims 10-12 are pending.

#### *Response*

Applicant's response and amendment to the claims filed on 6/30/2008 are acknowledged.

Claims 1-9 were rejected under 35 U.S.C. 112, first paragraph, because the specification although enabling for a process for preparing a final product of formula (I), wherein two of R1, R2, R3, and/or R4 come together to form a 5 membered heterocyclic ring, it is not enabled for a process for preparing all metal complexes without limitation (i.e. no formula in claims 1 or 2).

Applicant's arguments have been considered, but are not found persuasive. The scope of claims 1-9 reads on all "metal complexes." The term "metal complexes" is overly broad, unpredictable and beyond the scope of the enabling disclosure. It would cause a skilled artisan an undue amount of experimentation to determine which metal complexes would be the final product of the process. Therefore, as amended claims 1 and 2 are still rejected under 112, 1<sup>st</sup> for lack of enablement, while the rejection of amended claims 3-6 and 8 is withdrawn. Claims 7 and 9 are canceled and the rejection is withdrawn. In addition, new claims 10-12 are rejected for the same reason.

Claims 1-9 were rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Applicant's arguments have been considered, but are not found persuasive. The claims are rejected for omitting essential steps. The term "reacting" is the only step. The process uses known intermediates and does not state a final product other than it being a metal

complex, which reads on the prior art. Therefore, the process claim is indefinite because the metes and bounds of the claims are unknown. This rejection is maintained on claims 1-6, 8 and new claims 10-12 are rejected for the same reason.

Claims 1 and 2 were rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Applicant's arguments have been considered, but are not found persuasive. The "complexes of metals of groups 6 to 10 of the Periodic Table of the Elements" are not described in Claim 1. The complex of claim 3 should be inserted into claim 1 to overcome this rejection. This rejection is maintained.

Claim 9 was rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention and under 35 U.S.C. 101 because the claimed invention lacks patentable utility. Claim 9 is canceled and this rejection is withdrawn.

Claims 1-9 were rejected under 35 U.S.C. 102(b) and 35 U.S.C. 103(a) as being anticipated by and made obvious over McGuinness, et al (J.A.C.S., Vol. 123, No. 34, 2001). Applicant's arguments have been considered, but are not found persuasive. Applicants have inserted a proviso, but have not provided support for the proviso. The instant disclosure encompasses the process of McGuinness and at the time of filing it appears to be Applicant's intent to encompass the procedure outlined in McGuinness. In addition, should the proviso have support and not be found to be new matter, the process is still obvious to a skilled artisan. The claim is directed to a process wherein the selection of a metal compound member for the reaction is routine experimentation. It is well known in the art that the selection of reaction conditions is

mere optimization by more modification of routine experimentation and within one skilled in the art. Changes in temperature, concentration, or both is not patentable modification in the absence of unexpected results which is different in kind and not degree. In re Aller, 105 USPQ 233. In addition, it is well known in the art that a skilled artisan knows that if Pt, Pd, and Ni are disclosed that it is inherent that all Groups 6 to 10 metals are considered. (For example, see US Pat. No. 7,235,698, which discusses that a metal selected from Groups 6-10 in the Periodic Tables are customary metals (column 10, approx. lines 23-26). Therefore, this rejection is maintained.

New Matter Rejection Necessitated by Amendment

*Claim Rejections - 35 USC § 112*

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-6, 8 and 10-12 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

New or amended claims which introduce elements or limitations which are not supported by the as-filed disclosure violate the written description requirement. See MPEP §2163(I)(B). In the instant case, the original disclosure contained medicament claims, while the amended and

new claims are method claims. The specification must describe the claimed invention in sufficient detail that one skilled in the art can reasonably conclude that the inventor has possession of the claimed invention. (See MPEP §2163(I).) However, a showing of possession alone does not cure the lack of a written description. The issue is whether the specification as originally filed supports claims not originally in the application, i.e. **does the specification indicate that the proviso was the desired intent of the Applicant at the time the application was filed.** For example, in originally filed claim 6, the metals Ru, Rh, Ni, Pd, and Pt are specifically claimed. This is contrary to the proviso added in claim 1 because Ni, Pd, and Pt are Group 10 metals.

Claims 1-6, 8 and 10-12 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The amendment of the claims to add the proviso was not described in the specification in a way to convey that Applicant had possession or intent to claim methods of making.

Therefore, the material added to the claims incorporates “new matter” in violation of 35 U.S.C. 132.

***Claim Rejections - 35 USC § 112, 2<sup>nd</sup> paragraph***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 10-12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The term "method" renders the claim confusing because one skilled in the art would not know what type of method is being claimed. Is it a "method of making" or "method of preparing" or "method of using." Appropriate correction is required. The term "method" alone is indefinite and the metes and bounds of the claims are not known.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

***Telephone Inquiry***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Susannah Chung whose telephone number is (571) 272-6098. The examiner can normally be reached on M-F, 8am-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph McKane can be reached on (571) 272-0699. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Susannah Chung/  
August 7, 2008

/Joseph K. McKane/  
Supervisory Patent Examiner, Art Unit 1626